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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/926,277	09/05/97	VACHRIS	P 6357-19259

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MORRIS MANNING & MARTIN
1600 ATLANTA FINANCIAL CENTER
3343 PEACHTREE NE
ATLANTA GA 30326

EXAMINER	
ROSENBERGER,R	
ART UNIT	**PAPER NUMBER**
2877	

DATE MAILED: 04/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/926,277	Applicant(s) Vachris et al.
	Examiner Richard Rosenberger	Group Art Unit 2877

☒ Responsive to communication(s) filed on *Feb 7, 2000* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *24-37 and 45-63* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *24-37 and 45-63* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. The following is a quotation of the first and second paragraphs of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 26 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26 is dependent form cancelled claim 23; see the amendment filed 5 November 1998 for the current form and dependency of claim 26, and the amendment filed 7 February 2000 for the cancellation of claim 23. Claim 31 depends form claim 26; see the originally filed claims.

3. Claims 24, 25, 27-30, 32-37, 47 and 48 are rejected under 35 U.S.C. 112, first paragraph for not being properly supported by the specification as filed and under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is being claimed and how what is being claimed relates to what is disclosed. These claims all call for a "single electrode device" having two electrodes; that is contradictory.

There is no disclosure to support what is claimed. There are two distinct general embodiments of the invention as disclosed. The first, shown in figures 1, 1A, 3, 4 and 5, has a single electrode device and uses the object being measured as a second electrodes. The second embodiment, shown in figure 2, is a two electrode device, with the object being measured contacting one of the electrodes, which is flexible, These claims are a confused mixture of the two general embodiments. The independent claims rejected above (claims 24, 47 and 48) all call for a single electrode device with the object being used as an electrode, each having a power supply with "a second lead for coupling to a relief object" (claim 24; there is similar language in claims 47 and 48). Thus the claims are clearly claiming the first and not the second embodiment; in the second embodiment the power supply is not "coupled" to the relief object. However, all three independent claims also claim the presence of the second, flexible electrode. These they cannot be claiming the first embodiment, but are claiming the second, the first embodiment has no such flexible electrode, and is a single electrode device. Thus these claims are clearly both claiming and not claiming both embodiments in a unclear, confusing, and incorrect mixture of the two. The specification simply does not disclose a single electrode

device with two electrodes which uses both the object being measured as an electrode and also uses a flexible second electrode.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as obvious over Gaffney (WO 9716834).

Gaffney teaches the claimed use of a device with two electrodes, one of them being a flexible electrode, a light emitting layer between the electrodes, and a variable resistive layer between the flexible electrode and the light emitting layer. When a relief object is brought into contact with the flexible electrode, localized pressure gradients create a light image of the relief object. It would have been obvious to use any known variable resistive layer for that of Gaffney, the instant specification notes that the claimed variable resistive layers are known in the art (see the instant specification, page 15, line 1).

6. Claims 49-63 are are rejected under 35 U.S.C. 103(a) as being unpatentable over Derwent abstract XP-002080114, Derwent abstract XP-002080115 and the Abstract of Japanese patent 02126381.

All three references teach the basic disclosed invention. The use oaf any known electroluminescent material, be it organic or inorganic, would have been obvious. Those of ordinary skill could have made the surface any desired shape to accommodate the relief object to be measured; it is well-known in the art that fingerprints are curved and that curved surfaces can better accommodate fingerprints than flat surfaces. Those in the art could form that various parts of the device by any known manufacturing technique and of any known materials appropriate to the construction.

7. The remarks filed 7 February 2000 argue that claims 49, 57 and 62 show various construction details that are not shown by the references. It is, of course, obvious for those in the art to choose such construction details to make the devices such as disclosed. If the construction details claimed are not known in the art *per se*, then the disclosure relative to these details is certainly insufficient under 35 U.S.C. 112, first paragraph. The instant specification does not, for example, tell how to make a electroluminescent device having "a dielectric layer receiving dispersed light emitting particles" (claim 49) nor how to make a "thin, sublimed molecular film deposited on" a surface. It is being assumed thus far that these

techniques are known in the art, and therefore that the mention of them is sufficient to teach those in the art how to make the disclosed devices. However, it they are not known *per se*, then applicant should so state so appropriate rejections under 35 U.S.C. 112, first paragraph can be made.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 308-7722.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (703) 308-4804.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
20 April 2000